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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,546	05/25/2001	Jeyhan Karaoguz	41044/SDB/B600	4796
23363	7590	12/07/2004	EXAMINER	
CHRISTIE, PARKER & HALE, LLP			MARTINEZ, DAVID E	
PO BOX 7068			ART UNIT	
PASADENA, CA 91109-7068			PAPER NUMBER	
			2182	

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/866,546		KARAOGUZ ET AL.	
	Examiner		Art Unit	
	David E Martinez		2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Oath/Declaration

Examiner notes the reception of a copy of the executed declaration.

Claim Objections

Claims 14 and 20 objected to because of the following informalities: the word "a" before the word "performed" should be deleted on both claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-8, 14, and 20, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Claims 3-8 contain the trademarks/trade names "Bluetooth" and "HomeRF". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe different types of wireless communication standards, accordingly, the identification/description is indefinite.

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Furthermore, Claims 6-8 contain the 802.11b standard also creates an indefinite situation since standards are always subject to interpretation and are constantly being updated to different specification versions.

1. With regards to claims 14 and 20, "wherein each scan" is not clear as to whether it is referring to each window scan or each multiple scan inside each window scan. Due to the vagueness and a lack of clear definiteness in the claims, the claims have been treated on their merits as best understood by the examiner.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 9-11, 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,546,211 to Devon.

1. With regards to claims 1 and 2, Devon teaches a method for controlling and managing wireless network access for a wireless communication device [abstract], comprising the steps of:

sequentially attempting to determine whether communications may be established with least one a plurality wireless networks [column 5 line 64 to column 6 lines 4, and 27-35];

selecting least one of the wireless networks [column 5 line 64 to column 6 lines 4, and 27-44]; and

establishing communications between the wireless communication device and least one selected wireless network [column 5 line 64 to column 6 lines 4, and 27-44].

2. With regards to claims 9 and 15, Devon teaches the method of claim 1 comprising sequentially scanning a first network and a second network [Nevo abstract, column 3 lines 28-

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45, column 4 lines 13-15, 46-55, and Devon, abstract, column 2 lines 30-36, column 5 line 64 to column 6 lines 4, and 27-35] for the same reasons as those set forth in claim 1 above.

With regards to claims 10 and 16, Devon teaches the method of claim 1 comprising scanning a during a first scanning window and scanning a second network during a second scanning window [abstract, column 2 lines 30-36, column 5 line 64 to column 6 lines 4, and 27-35] for the same reasons as those set forth in claim 1 above.

3. With regards to claims 11 and 17, Devon teaches the method claim 10 wherein the first scanning window comprises a first predefined time period and the second scanning window comprises second predefined time period [abstract, column 2 lines 30-36, column 5 line 64 to column 6 lines 4, and 27-35] for the same reasons as those set forth in claim 1 above].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3-8, 12-14, 18-20 ddas, are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,546,211 to Devon in view of US Patent No. 6,600,726 to Nevo et al.

4. With regards to claims 3, 4, 6, 7, Devon teaches all of the limitations as disclosed to the steps and functions for claims 1 and 2 above except for the use of any two of the Bluetooth, HomeRF, and 802.11b network protocols.

However, Nevo teaches the use of any two of the Bluetooth, HomeRF, and 802.11b networks protocols in a dual-mode controller for a wireless device for the benefit of being able to communicate with a broad range of devices that use different protocols [column 3 lines 28-45,

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column 4 lines 13-15, 46-55]. In addition, Bluetooth, HomeRF and 802.11b network protocols are well known in the art as admitted by the Applicant [see Remarks, page 8, lines 2-6].

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Devon, Nevo and those that are well known, to include any two of Bluetooth, HomeRF, or 802.11b network protocols to perform the above steps/functions for the benefit of being able to communicate with a broad range of devices that use different protocols.

5. With further regards to claims 4 and 7, they are rejected under the same rationale as claim 3 above except for notifying the user of availability of types of networks and selecting a Bluetooth or a HomeRF network or an 802.11b network according user input. However, Hollstrom teaches a wireless device that displays to a user, modules available to communicate with, wherein the modules use different protocols for communication (bluetooth, cable, rs232). Hollstrom also discloses selection of a module as per user input [paragraphs 25 and 28, see figures 1 and 2]. Hollstrom does this to provide an easier way of accessing, controlling and operating electronic utility devices in a standardized and user-friendly fashion, and to drastically reduce the number of required control units so that one control apparatus is requires to control a large number of electronic devices.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Devon, Nevo, and Hollstrom to notify the user of availability of types of networks and selecting from a Bluetooth, a HomeRF or an 802.11b network according to user input for the benefit providing an easier way of accessing, devices in a standardized and user-friendly fashion, and to drastically reduce the number of required control units so that one control apparatus can access a large number of electronic devices.

6. With regards to claims 5 and 8, the combination of Devon and Nevo teach using common radio circuitry for communications with any two of the Bluetooth, HomeRF, or 802.11b

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networks [Nevo column 3 lines 28-45, column 4 lines 13-15, 46-55] for the same reasons as claims 3-7 above.

With regards to claims 12 and 18, it is well known in the art for scanning windows to be of equal predetermined time in order to be fair, and to prevent starvation.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have the first predefined time period equal the second predefined time period in order to be fair, and to prevent starvation.

7. With regards to claims 13 and 19, it is well known in the art for a wireless device to perform multiple scans when searching for a network. A conventional cellular phone is an example of a wireless device that performs multiple scans for a network signal that uses different protocols to communicate at different frequencies for the benefit of establishing a connection for communication to take place. It would have been obvious to one of ordinary skill in the art to perform multiple scans during the first scanning window and performing multiple scans during the second scanning window such as what a conventional cellular phone does for the benefit of establishing a connection for communication to take place.

8. With regards to claim 14 and 20, Devon teaches the method of claim 13 wherein each scan is performed for a predefined time period [column 5 line 64 to column 6 lines 4, and 27-44].

Response to Arguments

Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments with respect to the 112 2nd paragraph rejection to claims 3-8 have been fully considered but they are not persuasive.

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With respect to claims 3-8 Bluetooth, and HomeRF, as disclosed above, the claims are not sufficiently definite. Although they are well known standards as asserted by the applicant, they are standards that are always subject to interpretation and are constantly being updated to different specification versions. Furthermore, where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E Martinez whose telephone number is (571) 273-4152. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A Gaffin can be reached on (571) 272-4146. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DEM



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